

RECEIVED
CENTRAL FAX CENTER

JUN 21 2007

REMARKS**Response to Specification**

The Examiner objected to the specification because the Abstract is too long, i.e. more than 150 words. In response applicants have amended the Abstract to reduce the number of words to less than 150.

Response to Claim Objections

The Examiner objected to claim 32 because the claim refers to cancelled claim 31. In response applicants have amended claim 32 to depend from claim 30. The Examiner also objected to claims 17, 21, 30, 40, 48, 50-55, 57 and 57 because they contain the term "its" which rendered the claims indefinite. In response applicants have deleted reference to the term "its" from these claims.

Response to Allowable Subject Matter

Applicants note that the Examiner has withdrawn the indicated allowability of claims 28 and 33 based upon the newly found reference McGuckin, Jr. (US 6,280,450)

Response to Claim Rejections Under 35 U.S.C. §102(e)

The Examiner has rejected claim 17, 21, 25, 27, 28, 48, 50-53, 55-57 and 61 under 35 U.S.C. §102(e) as being anticipated by McGuckin, Jr. (US 6,280,450). In the rejection of these claims the Examiner contended that the device of McGuckin, Jr. has an elongated shaft, a distal end on the shaft, a tissue cutting member on the distal end of the shaft and an elongated electrosurgical tissue cutting member on the distal shaft section proximal to the tissue cutting member on the distal end.

However, applicants believe that the Examiner has misinterpreted this reference. The device described in the McGuckin, Jr. has no extension between the distal end

(mistakenly identified as the proximal end) of the shaft (20) and the point (65). With the McGuckin, Jr. device, the proximal end of the cutting members are secured to the distal end of the shaft (20) and the distal end of the shaft must be advanced distally toward the tip (65) in order for the tissue cutting members to expand. See column 7, lines 30-37 of McGuckin, Jr..

To clarify the above claims, applicants have introduced language calling for the electrosurgical cutting member to be on the distal shaft portion that is proximal to the distal end of the shaft and to be secured to and supported by the distal shaft portion. The distal ends of the tissue cutting members of McGuckin, Jr. are distal to the distal end of the shaft and are secured to the tip (65). The tip (65) is thus supported by the tissue cutting members not the shaft. The McGuckin, Jr. device has no shaft support between the tip (65) and the distal end of the shaft. Distal movement of the distal end of the shaft (20) is necessary to expand the tissue cutting elements of McGuckin, Jr.

Applicants believe that the McGuckin, Jr. reference fails to teach all the features of the above claims because it does not teach an electrosurgical cutting element secured to a distal shaft portion which is proximal to the distal end of the shaft. Therefore the reference fails to anticipate these claims.

Response to Claim Rejections Under 35 U.S.C. §103

The Examiner has rejected claims 18-20, 22-24, 58-60, 64-67 and 69 under 35 U.S.C. §103(a) as being unpatentable over McGuckin, Jr. as above and further in view of Patterson et al. (US 5,941,869). The Examiner contends that McGuckin, Jr. discloses a means for removing tissue from the body through the use of an encapsulating element, but fails to disclose the encapsulating element as being a band

or a plurality of bands that are actuatable between a retracted position and an extended position, the electrosurgical element comprising one of the encapsulating elements; the bands may be twisted for encapsulating the specimen and the specimen being encapsulated as the electrosurgical element is rotated about the longitudinal axis. The Examiner contends that it would be obvious to modify the means of McGuckin, Jr. to include the use of bands as the encapsulating element as per the teachings of Patterson et al.. The Examiner indicated that the combination would provide an alternative means of encapsulating the tissue prior to removal from the body.

However, applicants believe that the combination as proposed by the Examiner fails to meet the requirements of 35 U.S.C. §103(a), because the addition of the bands from Peterson et al. to the McGuckin, Jr. device fails to make up for the deficiencies as mentioned above in the response to the rejections under 35 U.S.C. 102(e). McGuckin, Jr. fails to teach having a longitudinally oriented, electrosurgical tissue cutting member disposed on the distal shaft section proximal to the distal end of the shaft. Adding the bands taught by Patterson et al. to the McGuckin, Jr. device does not result in a combination with all the claimed features, so the combination does not meet the requirements of 35 U.S.C. §103(a).

As stated in the Manual of Patent Examining Procedure (MPEP), 2143, the three basic criteria to establish a *prima facie* case of obviousness are:

- Prior art must teach all claim limitations
- There must be a suggestion or motivation to modify the reference or combine reference teachings
- There must be a reasonable expectation of success.

The cited prior art references, as applied by the Examiner, do not teach every feature of the claims in question. Specifically, the prior art does not teach a biopsy or tissue removal device having an elongated shaft with a distal end, a distal shaft portion proximal to the distal end and a electrosurgical cutting member on the distal shaft section. Furthermore, there would be no suggestion or motivation to combine the prior art references as suggested by the Examiner, because modifying McGuckin, Jr. to place the tissue cutter on the distal shaft section proximal to the distal end of the shaft would require a change in the operation of the McGuckin, Jr. device. Specifically, the McGuckin, Jr. device operates by advancing the distal end of the shaft toward the point (65) to expand the cutting members outwardly. Placing the electrosurgical cutting elements on the distal shaft portion proximal to the distal end would require another operation to expand the cutting members. While the motivation to combine references may be found in a number of sources, including the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art (See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998); *Dystar Textilfarben Gmbh v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006); and *Pfizer, Inc. v. Apotex, Inc.* (2007 U.S. App. LEXIS 6623), Applicants' disclosure is not one of those permitted sources.

Accordingly, it is clear that the three basic criteria for a *prima facie* case of obviousness have not been met for the claims rejected under 35 U.S.C. §103(a).

The recent Supreme Court decision *KSR International Co. v. Teleflex Inc. et al.*, 550 U.S. ____, (2007) does not appear to affect any of the above applicable law as applied to the present application.

RECEIVED
CENTRAL FAX CENTER

JUN 21 2007

Conclusions

Applicants believe that the pending claims are directed to patentable subject matter and respectfully request reconsideration and an early allowance thereof.

Respectfully submitted,

By: 

Edward J. Lynch
Registration No. 24,422
Attorney for Applicants

DUANE MORRIS LLP
One Market
Spear Tower, Ste. 2000
San Francisco, CA 94105
Telephone: (415) 957-3000
Facsimile: (415) 957-3001
Direct Dial: (415) 957-3067